



07 JUN 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. Box 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Danielle L. Herrit
Lahive & Cockfield, LLP
28 State Street
Boston, MA 02109

In re Application of :
KORSUNKY, Alexander :
Application No. 10/502,432 :
PCT No.: PCT/GB03/00283 : **DECISION ON PETITION**
Int. Filing Date: 24 January 2003 : **UNDER 37 CFR 1.181**
Priority Date: 25 January 2002 :
Attorney Docket No.: ISI-003US :
For: X-RAY DIFFRACTION METHOD :

This decision is in response to applicant's "Response to Notification of Missing Requirements under 35 U.S.C. 371 in the United States Designated/Elected Office" filed 13 May 2005, which is being treated as a Petition under 37 CFR 1.181.

BACKGROUND

On 24 January 2003, applicant filed the above identified international application which claimed priority date of 25 January 2002. Pursuant to 37 CFR 1.495, the thirty-month period for paying the basic national fee in the United States expired at midnight on 25 July 2004.

On 22 July 2004, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, inter alia,: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a copy of the international; a preliminary amendment; and a copy of a Declaration of Inventorship under PCT Rules 4.17(iv) and 51bis.1(a)(iv) filed during the international phase.

On 28 March 2005, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed. The notification set a two-month time limit in which to respond.

On 13 May 2005, applicant filed "Response to Notification of Missing Requirements under 35 U.S.C. 371 in the United States Designated/Elected Office."

DISCUSSION

As stated above, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed. Applicant states in the present response that, "the declaration was previously submitted in the international application under PCT Rule 4.17(iv) within the time limits provided for in PCT Rule 26ter.1." A review of the application reveals that the declaration "Declaration of Inventorship under PCT Rules 4.17(iv) and 51bis.1(a)(iv) for the purposes of the designation of the United States of America" is not in compliance with 37 CFR 1.497(a)-(b).¹ Specifically, the declaration is defective pursuant to 37 CFR 1.497(a)(2), in that, the declaration does not identify the international application number to which it is directed. Therefore, applicant is required to submit a newly executed declaration which identifies the above identified application.

CONCLUSION

The petition under 37 CFR 1.181 is DISMISSED without prejudice.

A proper response must be filed within **ONE MONTH** from the mail date of this decision and must include a proper declaration in compliance with 37 CFR 1.497(a)-(b) executed the named inventor. No extensions of this time limit may be obtained under 37 CFR 1.136(a), but the period for response set forth in the Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) mailed 28 March 2005 may be extended up to a maximum of five months.

Any further correspondence with respect to this matter should be addressed to: Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Telephone: 571-272-3298
Fax: 571-273-0459

¹See also Administration Instruction under the Patent Cooperation Treaty Section 214(a) which states: a declaration of inventorship, referred to in Rule 4.17(iv), that is made for the purpose of the designation for the United States of America shall be worded as follows: . . the declaration is directed to international application No. PCT/... (if furnishing declaration pursuant to Rule 26ter).